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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,351	10/31/2003	Ronald James Jandacek	9129L	2523

27752 7590 03/08/2006

THE PROCTER & GAMBLE COMPANY
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EXAMINER

GEMBEH, SHIRLEY V

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/699,351	Applicant(s) JANDACEK ET AL.	
	Examiner Shirley V. Gembeh	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-78 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Minor correction

The claim has been renumbered and changed from 73 to read as 72 and the numbers followed are renumbered subsequently. The claims pending are from claims 1-78.

Response to restriction requirement

Applicant's arguments, see page 3 of remarks, filed 1/9/06, with respect to the restriction requirement of claim(s) 1-79 have been fully considered and are persuasive. Therefore, the restriction is withdrawn. However, upon further consideration, a new ground(s) of restriction is made.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-36, 71 are, drawn to a composition, classified in class 514 in various subclasses depending on the stiffening agent and lipase inhibitor
- II. Claims 37-48 are, drawn to a method of increasing viscosity of one or more lipophilic substances, classified in class 514, subclass in various subclasses depending on the stiffening agent and lipase inhibitor.
- III. Claims 49-58, 72 are drawn to method of treating gastrointestinal distress, fecal urgency obesity etc, classified in class 514 in various subclasses depending on the stiffening agent and lipase inhibitor and the type of disease treated.

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- IV. Claims 59-70, 73-79, drawn to a kit, classified in class 514, subclass in various subclasses depending on the stiffening agent and lipase inhibitor.

The inventions are distinct, each from the other, for the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case Increasing viscosity can be employed by another method, adding oats to the diet (see British J. of Nutrition 2001).

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case Increasing viscosity in the gastrointestinal tract can be employed by another method, adding oats to the diet (see British J. of Nutrition 2001).

Inventions IV and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product. See MPEP § 806.05(h). In the instant case Increasing viscosity in the gastrointestinal tract can be employed by another method, adding oats to the diet (see British J. of Nutrition 2001).

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case Increasing viscosity in the gastrointestinal tract can be employed by another method, adding oats to the diet (see British J. of Nutrition 2001).

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case Increasing viscosity in the gastrointestinal tract can be employed by another method, adding oats to the diet (see British J. of Nutrition 2001) and the kit is a combination of the product with direction.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product. See MPEP § 806.05(h). In the instant case Increasing viscosity in the gastrointestinal tract can be employed by another method, adding oats to the diet (see British J. of Nutrition 2001) and the kit is a combination of the product with direction.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. For example increasing viscosity can be done with another different material, using corn starch as a thickening agent.

The Groups have acquired a separate status in the art by their recognized, divergent subject matter. The searches required for each Group are not co-extensive resulting in an undue burden to the Examiner. Each Group is capable of supporting a separate patent.

Restriction for examination purposes as indicated is proper. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The practice, re: Markush claims encompassing multiple independent and patentably distinct inventions is set for the in M.P.E.P. 803. The following requirement to make a provisional election of a single independent and patentably distinct invention is made pursuant to said practice.

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Claims 1, 13, 25, 31, 3743, 49, 54, 59, 65, 68, 71, 7273, and 78 are drawn in Markush format encompass multiple and patentably distinct inventions. The claims are either drawn to different compounds and combinations as well as the treatment of a variety of diseases as shown below.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for the composition and or kit for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Further, Applicant is required to elect a single disclose treatment for the treatment. Here, the claims recited such a multiplicity of species that an unduly extensive and burdensome search would be necessary if all of the claimed species were to be examined simultaneously. It is considered that at Markush type claim encompassing such species is directed to multiple independent and patentably distinct inventions since the species are so unrelated and diverse that a prior art reference anticipating the claims with respect to one of the species will not render the claim anticipated or obvious under 35 U.S.C. 102 nor 35 U.S.C. 103 respectively with regard to any one other of the species. Further these species are considered to be independent since they are unconnected in operation, one does not require the others for ultimate use and the specification does not disclose a dependent relationship between them. Moreover, each of the stated species is considered patentably distinct from the others on the basis of its properties. Thus, the stated species are capable of supporting separate patents under 35 U.S.C. 121.

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For the above reasons, an election of a single disclosed species for examination purposes is deemed necessary and proper in the practice of any one of the groups I-IV. Applicant needs to indicate in the response which group is elected and which species is elected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembah whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SVG
3/2/06


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